

REMARKS

At the time of the Sixth Office Action dated July 25, 2008, claims 1-5 were pending and rejected in this application. Dependent claim 11 has been added, and Applicants respectfully submit that no new material has been added.

CLAIMS 1-5 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON RADTKE ET AL., U.S. PATENT PUBLICATION NO. 2002/0113810, IN VIEW OF HARTMAN ET AL., U.S. PATENT NO. 6,615,266 (HEREINAFTER HARTMAN), JEFFRIES ET AL., U.S. PATENT NO. 6,094,529 (HEREINAFTER JEFFRIES), AND HOMER ET AL., "INSTANT HMTL" (HEREINAFTER HOMER)

On pages 2-6 of the Sixth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Radtke in view of Hartman, Jefferies, and Homer to arrive at the claimed invention. This rejection is respectfully traversed.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."¹ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.² "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the

¹ In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

² KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

subject matter sought to be patented.³ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover, before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁴ This burden has not been met.

On page 3 of the Sixth Office Action, the Examiner relied upon Hartman to teach the claimed "inserting a row in said markup specified form in a position which is proximate to said input-element." Although the Examiner relied upon column 9, lines 55-59 to teach "displaying error message on the line below to the data entry field that contains the error," upon reviewing the Examiner's cited passage, Applicants are unclear as to where Hartman specifically teaches that a row is inserted in the markup specified form. Hartman teaches that the Web page is generated with the error message in close proximity, but Hartman fails to teach how.

In the last full paragraph on page 3 of the Sixth Office Action, the Examiner asserted the following:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hartman and Radtke to provide the error message in different positions proximate to the error input elements to inform the user of error, since below or/and next is one form of proximate position.

Applicants are unclear as to the Examiner's logic. Being "below or/and next is next is one form of proximate position" does not describe a benefit or rationale for the proposed modification.

³ Id. (quoting Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17–18 (1966)).

⁴ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Instead, this statement appears to be a restatement as to the modification. Moreover, the Examiner's other statement fails to provide a realistic motivation to modify Radtke in view of Hartman to arrive at the claimed invention since providing the error message, irrespective of where the error message is located, is able "to inform the user of the error." Thus, Applicants submit that one having ordinary skill in the art would not have arrived at the claimed invention based upon the Examiner's rationale.

Applicants, therefore, respectfully submit that the imposed rejection of claims 1-5 under 35 U.S.C. § 103 for obviousness based upon Radtke in view of Hartman, Jefferies, and Homer is not viable, and hence, Applicants solicit withdrawal thereof.

Claim 11

Dependent claim 11 clarifies that "the anchor tag is inserted after detecting the at least one validation error and prior to serving said markup specified form." The insertion of the anchor tag described by Homer occurs, presumably, when the HTML document/link is first created. On the contrary, the claimed invention recites that the anchor tag is inserted after detecting the at least one validation error and prior to serving said markup specified form. Applicants position, therefore, is that one having ordinary skill in the art would have not have considered such a modification to be obvious over the applied prior art.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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